IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	HICKS, Isreal	Attorney Docket No.	HICK-1-1002
Serial No.:	10/081,928	Group Art Unit:	3632
Filing Date:	February 20, 2002	Examiner:	CHAN, Korie H.
Title:	HOIST TIRE HANGER		

TO THE DIRECTOR

THIRD SUPPLEMENTAL APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37

The attached *Third Supplemental Appeal Brief* has been amended in response to the third Notification of Non-compliant Appeal Brief mailed April 29, 2008. In this *Third Supplemental Appeal Brief*, the structure, material or acts described in the specification corresponding to the appealed independent claims are specifically set forth in pages 5-14 of section V.

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I. REAL PARTY IN INTEREST

The real party in interest in the pending patent application is the inventor Isreal Hicks of Arlington, Washington.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant or appellant's counsel that will directly affect, be directly affected by, or have a bearing in the Board's decision in the pending appeal.

III. STATUS OF THE CLAIMS

Claims 26, 29, 30, 48, 50, 51, 53, 54, 55, 57, 58, and 60 are pending. Claims 1-11, 21-25, 27, 28, 31-47, 49, 52, 56, 59, and 61 are cancelled. Claims 12-20 are withdrawn. Claims 26, 29, 30, 48, 50, 51, 53, 54, 55, 57, 58, and 60 are appealed.

The appealed claims 26, 29, 30, 48, 50, 51, 53-55, 57, 58, and 60 stand rejected per a final Office Action mailed May 29, 2007. A list of these appealed claims may found in "Appendix A—Claims on Appeal", attached to this supplemental Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendments have been filed since the Examiner's May 29, 2007 final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claims 26, 30, 54, and 58 of U.S. Patent Application Serial No. 10/081,928 (hereinafter application '928) are generally directed to a tire hanger (see Figs. 1, 6, and 7) adjustably engagable with a horizontal member of an automotive lifting device or hoist (see pg. 2, lines 10-13) so that ergonomic handling of automobile tires by a worker can be

executed during mounting and dismounting procedures from a vehicle held by the automotive lifting device.

More specifically, independent **claim 26** recites a tire hanger comprising a device (20) (see Figs. 1, 6, and 7 and pg. 2, lines. 9,15, and 24) that is configured to removably engage a horizontal support member of a vehicle hoist (see Figs. 2, 4, 5 and pg.2, lines 10-13 and 29) at a user-selected position (see Figs. 2-5 and pg. 3, lines 7-8, 12-13, and 30-31). The device (20) has a first end (22) (see Figs. 1, 6, and 7 and pg. 2, lines 2-9). The first end (22) is arranged to be mounted by at least partially circumscribing the horizontal support member (see pg. 3, lines 3-4) without the need for fasteners (see Figs. 1, 6, and 7). The device (20) also includes a second end (26) (see Figs. 1, 6, and 7 and p. 2, lines 2-9). The second end (26) has a hook configuration (see Figs. 1, 6, and 7 and pg. 2, lines. 32-33). The device (20) further includes a middle section (24) disposed between the first end (22) and the second end (26), the middle section (24) having a length suitable for engaging the hook configuration with the wheel (see Figs. 1, 6, and 7 and pg. 2, lines 14-15.

Independent **claim 30** recites a tire hanger comprising a device (20) (see Figs. 1, 6, 7 and pg. 2, lines 1, 15, and 24 that configured to removably engage a horizontal support member (see Figs. 2-5 and pg 2, lines 10-13 and 29) of a vehicle hoist (see Figs. 2, 4, 5) at a user-selected position (see pg. 3, lines 7-8). The device (20) has a first end (22) (see Figs. 1, 6, 7 and pg. 2, lines 2-9) arranged to be mounted by at least partially circumscribing the horizontal support member (see pg. 3, lines 3-4) without the need for fasteners (see Figs. 1, 6, and 7). The device (20) further includes a second end (26) (see Figs. 1, 6, and 7 and pg 2, line 9) having a hook configuration (see Figs. 1, 6, 7) to engage a wheel (see Fig. 3 and pg. 2, lines 32-33) and a middle section (24) (see Figs. 1, 6, 7). The middle section (24) is disposed between the first end (22) and the second end (26), the middle section (24) further includes two portions connected by a pivotable joint (28) (see Figs. 1, 6; and specification pg. 2, line 16). The middle section (24) has a length suitable for engaging the hook configuration with the wheel (see pg. 2, lines 14-15)

wherein a weight bearing upon the second end (26) is conveyed through the middle section (24) to the first end (22) to secure the first end (22) on the horizontal support member (see pg. 2, line 26 and page 3, lines 4-5).

Independent **claim 54** recites a tire hanger comprising a first end (22) (see Figs. 1, 6, 7 and pg. 2, lines 2-9), the first end (22) being a U-shape with a horizontal top portion, a vertical rear portion, and a horizontal bottom portion, the U-shape defining a recess adapted to removably engage a horizontal support member of a vehicle hoist (see pg. 2, lines 10-11 and pg. 3, lines 3-4) without fasteners (see Figs. 1, 6, and 7). The tire hanger also includes-a second end (26) (see Figs. 1, 6, 7; and pg. 2, lines 2-9). The second end (26) is connected to the first end (22), the second end (26) has a hook configuration (see Figs. 1, 6, 7) and a sufficient length for engaging a wheel (see Fig. 3 and pg. 2, lines 32-33) wherein a weight bearing on the hook configuration is conveyed to the first end (22) to secure the first end (22) to the horizontal support member of the vehicle hoist (see pg. 2, line 26 and page 3, lines 4-5).

Independent **claim 58** recites a tire hanger comprising a hoist wrap section (22) (see Figs. 1, 6, 7 and pg. 2, lines 2-9) having an open end (32) (see Figs. 1, 6, 7 and pg. 2, lines:10-12) arranged to removably engage with at least three sides of a horizontal support member (see Figs. 1, 2, 4-7 and pg. 2, lines 10-11 and 29) of a vehicle hoist. The tire hanger also includes a tire hanging section (26) arranged to engage a wheel (see Fig. 3 and pg. 2, lines 32-33) and a middle section (24) (see Figs. 1, 6, 7) that is disposed between the hoist wrap section (22) and the tire hanging section (26); whereby the hoist wrap section (22) is shaped so as to contact and slidably engage the at least three sides of the horizontal support member (see pg. 2, lines 11-13 and pg.3, lines 3-6).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Do claims 26, 29, 30, 48, 50, 51, 53-55, 57, 58, and 60 lack novelty under 35 U.S.C. §102(b) as being anticipated by Zarnick.

(2) Do claims 58 and 60 lack novelty under 35 U.S.C. §102(b) by Starling.

VII. ARGUMENT

A. Claims 26, 29, 30, 48, 50, 51, 53-55, 57, 58, and 60 are not anticipated Under 35 U.S.C. § 102 as being anticipated by Zarnick.

1. Reference Relied Upon For §102(b) Rejection

In the rejection under 35 U.S.C. § 102 (b), the Examiner rejected Claims 26, 29, 30, 48, 50, 51, 53-55, 57, 58, and 60 as being unpatentable over U.S. Patent No. 5,816,016 (hereinafter "Zarnick").

Figure 2 of Zarnick is reproduced here.

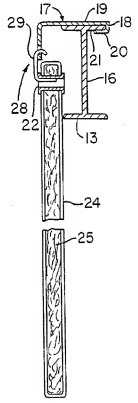


FIG. 2

The device of Zarnick is a hook clip for hanging acoustical panels from I-beams. The hook clip 17 has a hook end 18 that hooks on an upper flange of an I-beam, and the acoustical panel holds the hook end 18 securely on the flange. Preferably the hook end is bent so that the sides of the hook end 19, 20 grip the upper flange. The clip end comprises a rigid bent portion 29 one end of which secures the panel, and another end of which fits within an opening in the hook clip 17. (Col. 2, lines 3-13.)

2. Claims 26, 29, 30, 48, 50, 51, 53, 54, 55, 57, 58, and 60 were Improperly Rejected Under §102(b)

Claims 26, 29, 30, 48, 50, 51, 53-55, 57, 58, and 60 were improperly rejected under 35 U.S.C. § 102(b) as being anticipated by Zarnick. Claims 29, 48, and 50 depend from independent claim 26. Claims 51 and 53 depend from independent claim 30. Claims 55 and 57 depend from independent claim 54. Claim 60 depends from independent claim 58.

The prior art patent cited in a 35 U.S.C. §102(b) rejection must disclose each and every limitation found in the claims, either expressly or inherently. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under §102. *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

In the present case, the rejection is improper, and fails to establish anticipation under §102, because the invention of Claims 26, 30, 54, and 58 includes limitations not present, either expressly or inherently, in the cited reference.

(a) The limitations on Applicant's "first end" are not disclosed by Zarnick.

Zarnick fails to disclose the "first end" as recited in Claims 26, 30, and 54 (or the "hoist wrap end" of Claim 58). The Claims include the following limitation not found in the Zarnick reference.

- "a first end arranged to be mounted by at least partially circumscribing the horizontal support member without the need for fasteners"

The hook end 18 of Zarnick is not "arranged to be mounted by at least partially circumscribing the [vehicle hoist] horizontal support member without the need for fasteners." Zarnick's "hook clip [] consists of a 1"-1½" metal strip with a bend section of metal at a hook end…the hook end is attached to an upper flange of the I-beam" (col. 1, lines 38-40). A user of the method of Zarnick "lock[s] the hook end (18) on the opposite upper flange of the I-beam…[p]referably the hook end is bent so that the sides of the hook end (19) and (20) grip the upper flange" (col. 2, lines 1-8). Applicant is unsure how to interpret the dimensions given for the hook clip, but the least favorable (to Applicant) interpretation is that the horizontal portion of the hook clip (as shown in Fig. 2) is 1½" long; using this dimension yields a hook end that is sized to accommodate an I-beam flange no more than 0.09" thick. Applicant asserts that it is impossible to "partially circumscribe the [vehicle hoist] horizontal support member", as required by the claims, with a hook end sized to accommodate a 0.09" vehicle hoist horizontal support member, because there are no vehicle hoist horizontal support members with a width of 1.5" and a thickness of 0.09 inches or less. Additionally, the hook end (19) of Zarnick faces towards the

I-beam, whereas Applicant's hook end faces away from the car hoist beam. This results in the acoustical panel (15) of Zarnick touching or rubbing against and being stabilized by the lower portion of the I-beam (13). In contrast, Applicant's tire hanging section 26 of tire hanging device 20 points away from the hoist *to self-support a tire without requiring hoist stabilization*. With wider tires, the edge of the tire may engage the hoist. In sum, Applicant's tire hanging device (20) is configured differently from Zarnick's second hook end such that the Appellant's hook end (26) points away the hoist and does not rely *solely* on hoist stabilization of the tire being hanged by the tire-hanging section (26) whereas Zarnick requires its hanged acoustical panel (15) to be stabilized by the I-beam (13) as illustrated in Zarnick's Figure 2.

(b) The limitations on Applicant's "second end" are not disclosed by Zarnick.

Zarnick fails to disclose the "second end" as recited in Claims 26, 30, and 54 (or the "tire hanging section" of Claim 58). The Claims include the following limitation not found in the Zarnick reference.

- "a second end having a hook configuration to engage a wheel"

The clip end 28 of Zarnick does not have "a hook configuration to engage a wheel" as required by Applicant's Claims 26, 30, 54, and 58. Given Zarnick's preferred dimensions (above), the horizontal length of the clip end 28 is about 0.53". Thus, Zarnick's second end is capable of engaging only those wheels with a width of no more than 1.06" (assuming that a tire up to twice as wide as the horizontal length of the clip end 28 would be sufficiently supported by the clip end 28). Applicant is not aware of any vehicle wheel meeting the dimensions required for use with Zarnick's device.

(c.) The limitations on Applicant's "middle section" are not disclosed by Zarnick.

Zarnick fails to disclose the "second end" as recited in Claims 26, 30, and 54 (or the "tire hanging section" of Claim 58). The Claims include the following limitation not found in the Zarnick reference.

- "a middle section disposed between the first end and the second end…having a length suitable for engaging the hook configuration with the wheel"

Zarnick's "middle section" does not have a "length suitable for engaging the hook configuration with the wheel" as required by Claims 26 and 30. Applicant assumes that the length of Zarnick's "middle section" is the combination of the lengths of the vertical portion of the hook clip 17 and the vertical portion of the clip end 28. That vertical distance, from the horizontal part of the rigid bent portion 29 to the horizontal portion of the hook end 18, is about 1.15". Thus, taking the preferred dimensions given in Zarnick, the middle section of Zarnick has a length suitable for engaging the hook configuration with a wheel having a radius of no more than 1.15". Applicant is unaware of any wheels with a radius of 1.15" or less, and thus asserts that the length of Zarnick's middle section is completely unsuitable for engaging the hook configuration with a wheel, as required by the claims.

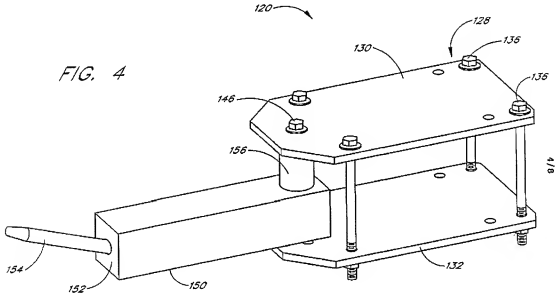
It is clear, then, that all of the limitations in Applicant's appealed claims are not taught by the cited reference. Therefore, the rejection under §102 was improper because all of the above-mentioned limitations are not taught, disclosed, or suggested in a single prior art reference. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

B. Claims 58 and 60 are not anticipated Under 35 U.S.C. §102(b) by Starling

1. Reference Relied Upon for §102(b) Rejection

In the rejection under 35 U.S.C. § 102, the Office Action rejected Claims 58 and 60 as being unpatentable over PCT Document No. WO 00/55031 (hereinafter "Starling").

Figure 4 of Starling is reproduced below.



The device of Starling is an apparatus (120) for supporting automotive tires having a hanger pin (154) adapted to fit through the mount hole of a vehicle wheel. The apparatus is intended to be installed on an automotive hoist at a height approximately the same as that of a tire of a vehicle disposed on the hoist. A worker removing a wheel from the vehicle disposed on the hoist (22) can thus hang the wheel on the apparatus without significantly bending at the waist. (Abstract). The hanger pin (154) of Starling engages with "a mounting hole of the tire/wheel assembly" per page 5, lines 18-20 of Starling. These mounting holes are commonly known as lug nut holes, which are smaller than axle holes of tire/wheel assemblies that

Appellant's tire hanging section (26) engages. Moreover, Starling is limited to only those tires having lug nut holes.

2. Claims 58 and 60 Were Improperly Rejected Under §102(b)

Claims 58 and 60 were improperly rejected under 35 U.S.C. § 102(b) as being anticipated by Starling. The prior art patent cited in a 35 U.S.C. §102 rejection must disclose each and every limitation found in the claims, either expressly or inherently. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Each claim limitation must be found in a single prior art reference; references cannot be combined under §102(b). *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000). Omission of any claimed element, no matter how insubstantial, is grounds for traversing a rejection based on §102(b). *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

In the present case, the rejection is improper, and fails to establish anticipation under §102(b), because the invention of Claims 58 and 60 includes limitations not present, either expressly or inherently, in the cited reference.

a. The limitations on Applicant's "hoist wrap section" are not disclosed by Starling.

Starling fails to disclose the "hoist wrap section" as recited in Claims 58 and 60. The Claims include the following limitation not found in the Starling reference.

- "a hoist wrap section having an open end arranged to removably engage with at least three sides of a horizontal support member of a vehicle hoist"

The "tire support bracket" 120 of Starling "comprises a mount body 128 having top and bottom mount plates 130, 132 which, when installed on a hoist 22, are disposed on opposite sides of the horizontal lift arm 26. Bolts 136 operate between the top and bottom mount plates 130, 132 to pull the plates together about the lift arm 26" (page 6, lines 11-16). As can be clearly seen in Starling's Figure 4, and indeed as pointed out in the May 29, 2007 final Office Action, there is no "open end" of Starling's hoist wrap section. Instead, as stated in the Office Action, "between the outer pair bolts 136 are opened spaces" (5/29/07 Office Action, page 3, lines 2-4). As the open spaces of Starling are not an open end as required by Claims 58 and 60, Starling cannot anticipate Applicant's Claims 58 and 60.

Starling fails to disclose engaging the axle hole of a tire/wheel assembly as taught by Appellant. Instead, the hanger pin (154) of Starling engages with "a mounting hole of the tire/wheel assembly" per page 5, lines 18-20 of Starling. Moreover, Starling is limited to mounting only tire/wheel assemblies having only mounting holes, and cannot be used for tire/wheel assemblies having axle holes that are larger and ergonomically easier to engage with Appellant's tire hanging section (26).

It is clear, then, that all of the limitations in Applicant's appealed Claims 58 and 60 are not taught by the cited reference. Therefore, the rejection under §102 was improper because all of the above-mentioned limitations are not taught, disclosed, or suggested in a single prior art reference. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 1363 (Fed. Cir. 1998); *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 20 (Fed. Cir. 2000); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

VIII. CONCLUSION

For the foregoing reasons, the Examiner's final rejections should be reversed and the pending claims should be allowed. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983).

Respectfully submitted,

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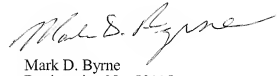

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APPENDIX A – Claims on Appeal

26. A tire hanger comprising:

a device configured to removably engage a horizontal support member of a vehicle hoist at a user-selected position, the device having:

a first end arranged to be mounted by at least partially circumscribing the horizontal support member without the need for fasteners;

a second end having a hook configuration to engage a wheel; and

a middle section disposed between the first end and the second end, the middle section having a length suitable for engaging the hook configuration with the wheel.

29. The tire hanger of Claim 26, wherein the middle section includes two portions connected by a pivotable joint.

30. A tire hanger comprising:

a device configured to removably engage a horizontal support member of a vehicle hoist at a user-selected position, the device having:

a first end arranged to be mounted by at least partially circumscribing the horizontal support member without the need for fasteners;

a second end having a hook configuration to engage a wheel; and

a middle section disposed between the first end and the second end, the

middle section including two portions connected by a pivotable joint, the middle section having a length suitable for engaging the hook configuration with the wheel;

wherein a weight bearing upon the second end is conveyed through the middle section to the first end to secure the first end on the horizontal support member.

48. The tire hanger of claim 26, wherein the first end is in the form of a U-shape.

50. The tire hanger of claim 26, wherein the device is constructed from a rigid material.

51. The tire hanger of claim 30, wherein the first end is in the form of a U-shape.

53. The tire hanger of claim 30, wherein the device is constructed from a rigid material.

54. A tire hanger comprising:

a first end, the first end being a U-shape with a horizontal top portion, a vertical rear portion, and a horizontal bottom portion, the U-shape defining a recess adapted to removably engage a horizontal support member of a vehicle hoist without fasteners; and

a second end, the second end connected to the first end, the second end having a hook configuration and a sufficient length for engaging a wheel;

wherein a weight bearing on the hook configuration is conveyed to the first end to secure the first end to the horizontal support member of the vehicle hoist.

55. The tire hanger of claim 54, wherein the second end overlaps and is pivotably connected to the first end.

57. The tire hanger of claim 54, wherein the first end and second end are constructed from a rigid material.

58. A tire hanger comprising:

a hoist wrap section having an open end arranged to removably engage with at least three sides of a horizontal support member of a vehicle hoist;

a tire hanging section arranged to engage a wheel; and

a middle section disposed between the hoist wrap section and the tire hanging section;

whereby the hoist wrap section is shaped so as to contact and slidably engage the at least three sides of the horizontal support member.

60. The hanger of Claim 58, wherein the tire hanging section is a straight member of sufficient length to hold a tire.

APPENDIX B – Evidence Submitted under 37 C.F.R. §§ 1.130, 1.131, 1.132

There is no evidence submitted under 37 C.F.R. §§ 1.130, 1.131, 1.132 related to this application.

APPENDIX C – Decisions Rendered by a Court or the Board in Related Appeals and Interferences

There are no decisions rendered by a Court or the Board related to this application.